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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,221	04/23/2001	Hiroshi Kitada	202305US2X	4740

22850 7590 05/05/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,221

Applicant(s)

KITADA

Examiner

Paul H. Kang

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10-29, 31-47 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-29, 31-47 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. MPEP § 719.05.

2. Claims 7, 30 and 48 have been cancelled. Claims 1-6, 8-29, 31-47 and 49-54 are now pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. ***Claim(s) 1-6, 8, 10-29, 31-47 and 49-54 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Parry et al. (US Patent Application No. 2002/0178213 and Parry hereinafter).***

5. As per claim(s) 1, 24, 46 Parry discloses:

requesting a transfer of an ASP document at an ASP user device connected to a remote document manager and a remote ASP via a network (See Figure 1 & Abstract);

determining whether said ASP document is a storage document for storing in said remote ASP or a retrieval document for retrieving from said remote ASP (See Paragraph(s) 0037-0042);

Art Unit: 2141

establishing a predetermined time for effecting a transfer of said ASP document; and transferring said ASP document at a predetermined time (i.e., spider) via said network (See Paragraph(s) 0100-0103, 0037-0042 & Figure 8).

6. As per claim(s) 2, 25 Parry teaches the claimed invention as described in claim(s) 1, 24 above and furthermore discloses sending a deferred transfer request to said remote document manager via said network when the ASP user device logs on to said remote document manager, (See Paragraph(s) 0034-0036).

7. As per claim(s) 3, 26, 47 Parry teaches the claimed invention as described in claim(s) 1-2, 24-25, 46 above and furthermore discloses logging on to said remote document manager by the ASP user device, (See Paragraph(s) 0076-0082) wherein said step of requesting a transfer comprises inputting a deferred transfer option from a menu received from said remote document manager via said network after said user device logs on to said remote document manager, (See Paragraph(s) 0076-0082).

8. As per claim(s) 4, 27 Parry teaches the claimed invention as described in claim(s) 1-3, 24-26 above and furthermore discloses inputting said predetermined time; and sending said predetermined time to said remote document manager via said network, (See Paragraph(s) 0100-0103 & Figure 8).

9. As per claim(s) 5, 28 Parry teaches the claimed invention as described in claim(s) 1-4, 24-27 above and furthermore discloses establishing a predetermined time for effecting a transfer of said ASP document comprises requesting said remote document manager to establish said predetermined time without sending a predetermined time to said remote document manager, (See Paragraph(s) 0099-0104 & Figure 8).

10. As per claim(s) 6, 29 Parry teaches the claimed invention as described in claim(s) 1-5, 24-28 above and furthermore discloses transferring said ASP document at a predetermined time via said network comprises transferring said ASP document via the Internet, (See Paragraph(s) 0100-0103 & Figure 8).

Art Unit: 2141

11. As per claim(s) 8, 31, 49 Parry teaches the claimed invention as described in claim(s) 1-7, 24-30, 46-48 above and furthermore discloses determining that said ASP document is a storage document based on an operator input to said ASP user device, (See Paragraph(s) 0038) wherein user makes request for a web page; and inputting said storage document into said ASP user device, wherein said transferring step comprises transferring said ASP document via said network at said predetermined time, (See Paragraph(s) 0039-0044).

12. As per claim(s) 10, 33 Parry teaches the claimed invention as described in claim(s) 1-9, 24-32 above and furthermore discloses inputting said ASP document into said ASP user device comprises downloading an electronic copy of said ASP document from an external source to a memory associated with said ASP user device, (See Paragraph(s) 0051-0055).

13. As per claim(s) 11, 34 Parry teaches the claimed invention as described in claim(s) 1-10, 24-33 above and furthermore discloses transferring said ASP document via said network comprises sending said ASP document to said remote document manager at said predetermined time, (i.e., spider), (See Paragraph(s) 0100-0103).

14. As per claim(s) 12, 35 Parry teaches the claimed invention as described in claim(s) 1-11, 24-34 above and furthermore discloses transferring said ASP document via said network comprises sending said ASP document to said remote ASP at said predetermined time, (i.e., spider), (See Paragraph(s) 0100-0103).

15. As per claim(s) 13, 36, 50 Parry teaches the claimed invention as described in claim(s) 1-12, 24-35, 46-49 above and furthermore discloses receiving a storage operation report at said ASP user device, (See Paragraph(s) 0112 & Figure 9).

16. As per claim(s) 14, 37 Parry teaches the claimed invention as described in claim(s) 1-13, 24-36 above and furthermore discloses receiving comprises receiving said storage operation report from said remote document manager, (See Paragraph(s) 0112 & Figure 9).

Art Unit: 2141

17. As per claim(s) 15, 38 Parry teaches the claimed invention as described in claim(s) 1-14, 24-37 above and furthermore discloses receiving said storage operation report from said remote ASP device, (See Paragraph(s) 0112 & Figure 9).

18. As per claim(s) 16, 39 Parry teaches the claimed invention as described in claim(s) 1-15, 24-38 above and furthermore discloses clearing said ASP document from a memory of said ASP user. Examiner takes Official Notice (see MPEP 2144.03) that the purpose of clearing any type of document in a computer networking environment were well known in the art at the time the invention was made. Specifically, clearing a "document" from memory is similar to deleting a file from a computer or simply flushing cookies from a users temporary directory wherein in all such types of erasures are known as clearing a document from a memory.

19. As per claim(s) 17, 40 Parry teaches the claimed invention as described in claim(s) 1-16, 24-39 above and furthermore discloses determining that said ASP document is a retrieval document based on an operator input to said ASP user device, (See Paragraph(s) 0037-0044); generating a document retrieval request in said ASP user device, (See Paragraph(s) 0037-0044); sending said document retrieval request to said remote document manager via said network, (See Paragraph(s) 0037-0044); and receiving said retrieval document at said predetermined time, (See Paragraph(s) 0037-0044).

20. As per claim(s) 18, 41 Parry teaches the claimed invention as described in claim(s) 1-17, 24-40 above and furthermore discloses receiving said retrieval document comprises receiving said retrieval document from said remote document manager at said predetermined time, (See Paragraph(s) 0100-0103 & Figure 8).

21. As per claim(s) 19, 42 Parry teaches the claimed invention as described in claim(s) 1-18, 24-41 above and furthermore discloses receiving said retrieval document comprises receiving said retrieval document from said remote ASP at said predetermined time, (See Paragraph(s) 0100-0103 & Figure 8).

Art Unit: 2141

22. As per claim(s) 20, 43, 52 Parry teaches the claimed invention as described in claim(s) 1-19, 24-42, 46-51 above and furthermore discloses generating a document retrieval result report, (See Paragraph(s) 0112 & Figure 9).

23. As per claim(s) 21, 44, 53 Parry teaches the claimed invention as described in claim(s) 1-20, 24-43, 46-52 above and furthermore discloses sending said document retrieval result report to said remote document manager via said network, (See Paragraph(s) 0112 & Figure 9).

24. As per claim(s) 22, 45, 54 Parry teaches the claimed invention as described in claim(s) 1-21, 24-44, 46-53 above and furthermore discloses sending said document retrieval result report to said remote ASP manager via said network, (See Paragraph(s) 0112 & Figure 9).

25. As per claim(s) 23 Parry teaches the claimed invention as described in claim(s) 1-22 above and furthermore discloses a computer readable medium containing program instructions for execution on a computer system, which when executed by the computer system, , (See Paragraph(s) 0023-0026, References cited for claims 1-22 above)

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- b. Determining the scope and contents of the prior art.
- c. Ascertaining the differences between the prior art and the claims at issue.
- d. Resolving the level of ordinary skill in the pertinent art.
- e. Considering objective evidence present in the application indicating obviousness or nonobviousness.

28. Claim(s) 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry et al. (US Patent Application No. 2002/0178213 and Parry hereinafter) in view of Courtney et al. (US Patent No. 5,519,786 and Courtney hereinafter).

29. As per claim 9 Parry discloses the claimed invention as described above.

However, Parry does not explicitly teach optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device.

Courtney teaches optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device (See Column 2 Lines 62-67 & Column 3 Lines 1-27).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Parry with the teachings of Courtney to include optically scanning a paper copy of said ASP document to provide a digital signal representative of said paper copy of said ASP document; and storing said digital signal in a memory associated with said ASP user device with the motivation to provide for useful and necessary means to transform data appearing in a hard-copy format to a format readable by and useful to computers, (See Courtney Column 1 Lines 18-25).

Claim Rejections - 35 USC § 102

30. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

31. **Claims 1, 24 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent**

Application Publication No.: US 2004/0215671 A1 to Hyakutake et al..

32. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

33. As per claim(s) 1, 24, 46 Parry discloses:

requesting a transfer of an ASP document at an ASP user device connected to a remote document manager and a remote ASP via a network (See Figure 1 & Abstract);

determining whether said ASP document is a storage document for storing in said remote ASP or a retrieval document for retrieving from said remote ASP (See Paragraph(s) 0004-0008; 0009-0010);

establishing a predetermined time for effecting a transfer of said ASP document; and transferring said ASP document at a predetermined time (i.e., spider) via said network (See Paragraph(s) 0004-0008; 0009-0010).

Response to Arguments

34. Applicant's arguments filed December 23, 2004 have been fully considered but they are not persuasive. Applicant argued in substance that the prior art of record failed to teach "determining whether the ASP document is a storage document for storing in the remote ASP or a retrieval document for retrieving from the remote ASP." To the extent that applicant may argue this limitation is not found in the cited portions of Parry (paragraphs 0036-0042), the recited limitation is deemed to be inherent to a distributed data processing network wherein data is stored and retrieved from a server. Necessarily, the system must determine whether the data is to be stored or retrieved. Therefore, the newly added limitation is not deemed to overcome the prior art of record.

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- f. Becker et al. (US Patent No. 6,658,452) discloses schemes for selecting and passing an application for an application provider to an application service provider;
- g. Smith et al. (US Patent No. 6,385,655) discloses method and apparatus for delivering document sever an electronic network; and
- h. Davis et al. (US Patent No. 6,615,233) discloses apparatus and method for transmitting documents between a server computer and a client computer;

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharja can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAUL H. KANG
PRIMARY PATENT EXAMINER